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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/539,382	03/31/2000	Alison A. McCormick	LSB-001/CIP	9680

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EXAMINER

BANSAL, GEETHA P

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 04/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/539382

Applicant(s)

McCormick et al

Examiner

Lyetta Bansal

Group Art Unit

1642

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 2/21/02

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-53 is/are pending in the application.

Of the above claim(s) 24-28, 30-36, 41-53 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-23, 29, 37-40 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 sheets

☐ Notice of Reference(s) Cited, PTO-892

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

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DETAILED ACTION

1. Applicant's preliminary amendments filed 10/2/2001(Papers No:6/A) are acknowledged.
2. Applicant's election without traverse of Group I (claims 1-23, 29, 37-40) in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
Accordingly, claims 1-23, 29, 37-40 are being examined.

Oath/Declaration

3. The Oath/Declaration is defective and a substitute needs to be submitted. Applicant's claim to priority to the provisional application 60/ 155979 must be claimed under 35 U.S.C. 119(e).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-23, 29, 37-40 are rejected under 35 U.S.C. 102(a) as being anticipated by McCormick et al (submitted in the IDS; January 1999-PNAS vol 96, pp 703-708).

The claims are drawn to a polypeptide self-antigen (encoded by nucleic acid wherein the polypeptide includes an epitope unique to tumor cells, produced recombinantly, duplicates the native epitope and is correctly folded and is immunogenic without adjuvants. Further claims specify the recombinant polypeptide self-antigen is produced in plants and has antigen binding regions of antibody molecule.

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McCormick et al teach the production of 38C13scFv in plants. McCormick et al at page 705, column 2 teach part (b) of claim 1; page 706, columns 1 and 2 teach parts (c) and (d). The production of the nucleic acid molecules encoding the self-antigen is taught in the references cited by McCormick et al (Reference No: 23, 27 also provided) as the methods used by them to produce the polypeptides as recited in claims 4-17, as well as formulating and administering them into subjects as recited in claims 18-23, 29, 37-40.

Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 1-23, 29, 37-40 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-23, 29, 37-40 of copending Application No. 09/522,900. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

8. Claims 1-23, 29, 37-40 of this application conflict with claims 1-23, 29, 37-40 of Application No. 09/522,900. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting

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claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

9. Claim 3 seems to have a typographical error as the correct dependency appears to be from claim 2, and not claim 21. Appropriate amendment to correct this error is requested.

10. No claim is allowed.

11. Papers related to this application may be submitted to Group 1640 by facsimile transmission. Papers should be faxed to Group 1640 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 308-4242 or (703) 305-3014.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Geetha P. Bansal whose telephone number is (703) 305-3955. The examiner can normally be reached on Mondays to Thursdays, and alternate Wednesdays from 7:00am to 4:30pm and alternate Fridays from 7:00am to 3:30pm. A message may be left on the examiner's voice mail service.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Anthony Caputa, can be reached on (703) 308-3995.

13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

April 22, 2002.



GEETHA P. BANSAL
PRIMARY EXAMINER